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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,176	11/02/2001	Danny Zhong Der Pang		8681

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EXAMINER	
LIU, SAMUEL W	

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,176	PANG, DANNY ZHONG DER	
	Examiner	Art Unit	
	Samuel W. Liu	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 7-10* is/are rejected.

7)☒ Claim(s) *6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the claims

Claims 1-10 are pending.

The applicant's amendment filed 3/8/05 , which amends claims 1-10, has been entered. Please note that the objection(s) and/or rejection(s) not explicitly stated and/or restated below are withdrawn.

Objection to claims

The disclosure is objected to because of the following informalities:

Claim 6 is objected to because there appears to be missing "and" before "pigmented spots" (the 3rd line of the claim).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the invention as now claimed.

This is a New Matter rejection for the following reasons:

The amended claims 3 and 8 recite "a human protein which is highly homologous to decorin polypeptide set forth as amino acid 1-329 of SEQ ID NO:6"; the recitation represents a departure from the specification and the claims as originally filed.

The instant claims now recite limitations which were not clearly disclosed in the specification and claims as filed, and now change the scope of the instant disclosure as filed. Such limitations recited in the present claims, which did not appear in the specification or original claims, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 3-5 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites "homologous to"; the recitation is unclear as to whether or not it refers to (i) functional homologous to, or (ii) structurally similar to based on structural motif(s)/consensus sequence(s), or (iii) amino acid sequence similarity or identity of decorin. The specification does not define this recitation. In addition, the phrase "highly homologous to..." is indefinite because "*highly*" *per se* does not set forth a clear-cut degree of the homology thereof. Without setting forth to what percentage of (polypeptide) sequence identity is compared, one cannot know the decorin homolog recited in claim 3, i.e., comparison of the decorin polypeptide of claim 3 to the

sequence consisting of amino acids 1-329 of SEQ ID NO:6 is unclear. See also claim 8. The dependent claims are also rejected.

Claim Rejections - 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruoslahti, E. I. et al. (US Pat. No. 5654270).

Ruoslahti et al. teach a pharmaceutical composition comprising decorin (see column 10, lines 8-26), which anticipates the instant claim 1.

Also Ruoslahti et al. teach that the said decorin is recombinantly produced (see Example 1, column 7, lines 62-65, and Figures 3A and 13), which anticipates the instant claim 2.

The applicant's response to the rejection under 35 USC 102

The response filed 3/8/05 argues that Ruoslahti's patent teaches pharmaceutical composition comprising decorin for condition, e.g., dermal wounds or cosmetic surgery, while the current invention sets forth a cosmetic or dermatological composition comprising decorin which is applied to normal skin or non-injury condition, and thus, the Ruoslahti's patent is not an anticipatory art (See page 1, the 4th paragraph).

The applicant's argument is found to be unpersuasive because the dermatological composition (recited in the instant claim 1) is applicable to treat skin lesions which includes skin burn (see abstract and column 1, lines 55-57 of US Pat. No. 5932228), and because preamble "cosmetic or dermatological" is considered to have a little patentable weight since it refers to an intended use for the composition claimed (note that the composition will not be altered due to the use of said composition for cosmetic or dermatological condition thereof.

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruoslahti, E. I. et al. (US Pat. No. 5654270).

Ruoslahti et al. teach a pharmaceutical composition comprising decorin (see column 10, lines 8-26) wherein the decorin is recombinantly produced (see Example 1, column 7, lines 62-65, and Figures 3A and 13), as applied to claims 1-2 of the current application.

Also, Ruoslahti et al. teach advantage of using the composition comprising decorin for cosmetic surgery (see column 9, lines 55-61), as applied to claims 6-7 of the current application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to be motivated by the above Ruoslahti et al. teachings because cosmetic surgery is considered as one of approaches to reducing skin aging which is the subject matter set forth in the instant claims 6-7. Thus, the skilled artisan would have been inextricably led to developing a method of treating the skin of human against skin aging. Therefore, the claimed invention was *prima facie* obvious to make and use the invention at the time it was made.

The applicant's response to the rejection under 35 USC 103

The response filed 3/8/05 argues that Ruoslahti's patent does not teach the method of treating the skin to reduce signs of skin aging, e.g., wrinkles which refers to treatment of normal skin while the Ruoslahti's method is applicable to treatment of wounded skin, e.g., cosmetic surgery. Thus, the applicant infers that the claimed method was not *prima facie* obvious to make and use the invention at the time it was made (see page 2 of the responds).

The applicant's argument is found to be unpersuasive because the claimed method is inherent in the Ruoslahti's patent disclosure, and because cosmetic surgery is considered as one of approaches to reducing skin aging. When the Ruoslahti's composition comprising decorin is applied to human skin (including normal and wound skin), the application would have inevitably

led to reducing skin aging as claimed in the current application. The burden is now shifted to applicant to establish how the said Ruoslahti's composition is not useful for the method thereof as the composition is applied in the cosmetic process.

Prior Art

The prior art made of record and not currently relied upon in any rejections is considered pertinent to Applicants' disclosure:

Ruoslahti E. et al. (US Pat. No. 5654270) teach a recombinantly produced decorin polypeptide which sequence comprises 2-329 amino acid residues of SEQ ID NO:6 of the current disclosure. Because the first residue of the Ruoslahti's sequence differs from that of SEQ ID NO:6, the Ruoslahti et al. patent is not considered as an anticipatory art over the instant claim 3 by Examiner.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu whose telephone number is 571-272-0949. The examiner can normally be reached from 9:00 a.m. to 5:00 p.m. on weekdays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber, can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4242 or 703 872-9306 (official) or 703 872-9307 (after final). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

SWL

Samuel Wei Liu, Ph.D.

April 18, 2005

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER